

Applic. No. 10/656,601

Amdt. dated November 7, 2005

Reply to Office action of August 5, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 22, 25-31, and 33-42 remain in the application. Claims 22, 25-27, 30, 32, 33, and 36-39 have been amended. Claims 23 and 24 are being cancelled herewith. Claims 1-21 were previously cancelled.

In item 1 on page 2 of the above-identified Office action, claims 22-32, 37, and 39 have been rejected as being fully anticipated by Matsumiya et al. (U.S. Patent No. 6,480,390 B2) (hereinafter "Matsumiya") under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in Fig. 2B and in claims 23, 24, and 26 of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 22 calls for, *inter alia*:

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the external contact being fixed relative to the housing, and at least one spring element for holding the moving protective element in the first position in an unplugged state, the spring element allowing the protective element to move into the second position counter to a spring force during the plug-in operation.

In the embodiments of Figs. 1 to 9b the Matsumiya reference does not disclose that the electrical contacts are not movable relative to the housing. In particular, the embodiments of Figs. 7-9b disclose a circuit board (41) that is slideably mounted in a housing (42). The housing (42) includes slit-like contact portion openings (30). By moving the circuit board (41) longitudinally in the housing, the connector element (40) can be selectively arranged at a first position where the contact portions (18) of the contacts (22) are exposed from the contact portion openings (30), or a second position where the contact portions (18) are contained in the housing (42) and not exposed to the openings (30) (column 6, lines 59-67).

In the embodiments of Figs. 10-15b, Matsumiya discloses that the electrical contacts are fixed with respect to the housing.

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The reference does not show the external contact being fixed relative to the housing, and at least one spring element for holding the moving protective element in the first position in an unplugged state, the spring element allowing the protective element to move into the second position counter to a spring force during the plug-in operation, as recited in claim 22 of the instant application. Matsumiya discloses a spring element in the embodiment of Figs. 7-9b. However, in the embodiment of Figs. 7-9b, the electrical contacts are moveable with respect to the housing. Matsumiya discloses that the electrical contacts are fixed with respect to the housing in the embodiment of Figs. 10-15b. Matsumiya does not disclose that any one embodiment discloses spring elements and external contacts that are fixed with respect to the housing. This is contrary to the invention of the instant application as claimed, in which the external contact is fixed relative to the housing, and at least one spring element holds the moving protective element in the first position in an unplugged state, the spring element allows the protective element to move into the second position counter to a spring force during the plug-in operation.

Furthermore, a person of ordinary skill in the art is not provided with any motivation to provide a spring element in

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the embodiment that has the external contacts fixed with respect to the module housing.

In the embodiments shown in Figs. 10-12 of Matsumiya there is an open/shut button (54). There is no teaching to use such an open/shut button (24) with a spring element. It would only be reasonable to do so if the open/shut button were to interact with another element of the coupling partner during a plug-in operation, which it does not.

In the embodiments of Figs. 13a to 14b of Matsumiya, there is no motivation to provide a spring element. In the embodiments of Figs. 13a and 13b, a holding structure (77) is provided instead of a spring element (column 11, lines 31-35). The use of holding structures (77) teaches away from using a spring element.

In the embodiment of Figs 14a and 14b of Matsumiya, a dust cap (82) is provided. There is no motivation to provide a spring element in this embodiment. More specifically, the use of a spring element as claimed would require interaction with the respective element of a coupling partner, which is not disclosed or suggested in the description of the embodiment of Figs. 14a and 14b.

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In the embodiments shown in Figs. 15a and 15b of Matsumiya, a swinging dust cover is provided. There is no motivation for a person of ordinary skill in the art to provide a spring element with the swinging dust cover mechanism.

Based on the above given comments, claim 22 is not obvious over Matsumiya.

Since claim 22 is believed to be allowable, dependent claims 25-31, 37, and 39 are believed to be allowable as well.

Even though dependent claim 30 is believed to be allowable, the following remarks pertain to claim 30.

Applicant respectfully disagree with the Examiner's comments on pages 4 and 5 of the Office action, that with respect to claim 30, the elements "50" and "44" in Figs. 9a and 9b represent a stop element. In the embodiment of Figs. 7-9b, the element (50) serves to lock the circuit board (41) within the housing (42). The stop element (44) limits the relative movement between the circuit board (41) and the housing (42). However, both elements (50 and 44) do not represent a stop element for mechanically contacting the coupling partner during plug-in operation such that the moving protective

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element is moved into the second position and the electrical contact is exposed.

In fact, the embodiment of Figs. 7-9b of Matsumiya does not disclose any interaction with a coupling partner. Moreover, it is not expected. The Matsumiya reference pertains to a card-type peripheral device that is removably mounted on the body of a portable small-sized electronic apparatus (column 1, lines 10-13). All that is disclosed is a card-type peripheral device with a connector element. When attaching the card-type peripheral device with the body of an electronic apparatus, as in the embodiment of Figs. 7 to 9b, the circuit board (41) is moved by the user into the position represented in Fig. 9a. Afterwards, the card-type peripheral device is mounted on the electronic apparatus. There is no disclosure whatsoever in Matsumiya that there would be any interaction between the card-type peripheral device and the electronic apparatus such that a stop element of the protective element would mechanically contact a coupling partner during plug-in-operation and thereby move the protective element in the second position in which the electrical contact is exposed.

Furthermore, the Examiner cannot argue that the housing is the coupling partner mentioned in claim 30. This would not be

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correct because the housing is already part of the plug-in device, as recited in claim 22 of the instant application.

Claim 41 calls for, *inter alia*:

moving the moving protective element relative to the external electrical contact when the electric module is plugged into the holding structure such that the external electrical contact is exposed and contacts the electrical contact on the coupling partner.

The reference does not disclose moving the moving protective element relative to the external electrical contact when the electric module is plugged into the holding structure such that the external electrical contact is exposed and contacts the electrical contact on the coupling partner, as recited in claim 41 of the instant application. Instead, the Matsumiya reference discloses that the moving protective element is moved in a position such that the electrical contacts are exposed before the electrical module is plugged on a coupling partner. Matsumiya does not disclose that a protective element is moved relative to the electrical contacts such that the contact are exposed during the process of plugging an electric module into a holding structure. This is contrary to the invention of the instant application as claimed, which

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recites moving the moving protective element relative to the external electrical contact when the electric module is plugged into the holding structure such that the external electrical contact is exposed and contacts the electrical contact on the coupling partner

It is appreciatively noted from page 7 of the Office action that claims 33-35 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and to overcome the rejections under 35 U.S.C. §112, second paragraph, set forth in this Office action. It is respectfully noted that no rejections under 35 U.S.C. §112, second paragraph were set forth in the Office action.

Allowable claim 33 was amended to include the subject matter of independent claim 22 and intervening claims 23 and 32. Therefore, claim 33 is allowable. Since claim 33 is allowable, dependent claims 34 and 35 are allowable as well.

In item 15 on page 6 of the Office action, claims 36, 38, and 40 have been rejected as being obvious over by Matsumiya (U.S. Patent No. 6,480,390 B2) in view of Fischer et al. (U.S. Patent No. 6,857,791 B2) (hereinafter "Fischer") under 35 U.S.C. § 103. Fischer does not make up for the deficiencies

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of Matsumiya. Since claim 22 is believed to be allowable, dependent claims 36, 38, and 39 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 22 or 41. Claims 22 and 41 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 22 or 41, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 22, 25-31, and 36-42 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,


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